IN THE UNITED STATES PATENT & TRADEMARK OFFICE

December 30, 2009

In re application of Valerie M. Bennett, et al.

Serial No.:   10/733,625

Filed: December 11, 2003

For: Intelligent Subscription Builder

Art Unit: 2443   Examiner: David E. England

APPELLANTS' BRIEF ON APPEAL

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA   22313-1450

Sir:

       This is an Appeal seeking reversal of the decision of the Primary Examiner, rejecting all

current claims of the subject patent application.

1)   REAL PARTY IN INTEREST

The real party in interest is the Assignee, International Business Machines Corporation ("IBM").

2)   RELATED APPEALS AND INTERFERENCES

Commonly-assigned and co-pending related application serial number 10/733,985 is currently under appeal, with an Appeal Brief filed on January 21, 2009. The Appeal number for this related application is 2009-013555.

Appellants, the Appellants' legal representative, and the assignee, have no personal knowledge of any other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

3)   STATUS OF CLAIMS

Claims 1, 3 - 4, and 13 - 21 stand rejected. Claims 2 and 5 - 12 were previously cancelled from the application without prejudice. The rejection of Claims 1, 3 - 4, and 13 - 21 is appealed herein. (Note that para. 1 of the Office Action dated July 31, 2009 incorrectly includes Claim 6 in the list of claims which are presented for examination. Claim 6 was cancelled without prejudice in Appellants' submission dated May 20, 2009.)

4)   STATUS OF AMENDMENTS

A Non-Final (fourth) Rejection was mailed on July 31, 2009. No amendments have been filed responsive to this Rejection.

5)   SUMMARY OF CLAIMED SUBJECT MATTER

1.   Independent Claim 1 is directed to a computer-implemented method of enabling users to

subscribe to content in a computing environment (Claim 1, lines 1 - 2; Specification, p. 2, lines 1 -

3, "... enabling end users to subscribe to information content ..."; p. 7, lines 17 - 19, "Use of the

present invention enables content providers ... to pro-actively offer content subscriptions to

[users]"). Claim 1 further recites that this method comprises:

- identifying a <u>content access behavior pattern</u> of a user (Claim 1, line 3;

    Specification, p. 7, lines 2 - 3, "The present invention provides techniques that

    enable a content provider to use programmatically-discovered/observed behavior

    patterns of users ..."; Specification, p. 9, lines 17 - 18, "The sample Web page 100

    depicted in Fig. 1 is used herein to illustrate how an end user's behavior patterns

    may be observed and used to offer that user a content subscription ...");

- responsive to the identifying, consulting a <u>mapping</u> to determine a <u>candidate</u>

    content subscription <u>to be offered to users</u> exhibiting the identified behavior

    pattern, the candidate content subscription indicating at least one portion of

    content generated by a content source (Claim 1, lines 4 - 6; Specification, p. 7,

    lines 3 - 5, "... automatically query the users to determine whether they would like

    to subscribe to content which is ... relevant to the behavior patterns";

    Specification, p. 12, lines 12 - 19, "... [an] inference engine may provide its

    observations [about identified user behavior patterns; Specification, p. 12, lines 2 -

    3] to the CP2XML component ... [which then] consult[s] a mapping that

    associates selected behavior patterns with content subscriptions ... As yet another

approach, a separate code component may be used [instead of the CP2XML component] for making this comparison ...");

- generating a <u>markup language document</u> representing the determined candidate content subscription (Claim 1, lines 7 - 8; Specification, p. 16, lines 6 - 14, explaining that an XML document is created and used to generate a "candidate subscription page for presentation to the user, an example of which is depicted in Fig. 4"; Specification, p. 24, lines 10 - 17, discussing an XML document that specifies customization information (e.g., as shown in **Fig. 8**) which is then formatted "into key-value pairs [for example] ... specifying conditions that are to be considered as a match when the content matching engine evaluates content");

- <u>offering</u>, to the user, <u>a subscription</u> to the candidate content subscription using a graphical user interface constructed using the markup language document (Claim 1, lines 9 - 10; Specification, p. 7, lines 3 - 5, "... automatically query the users to determine whether they would like to subscribe to content which is ... relevant to the behavior patterns"; Specification, p. 15, lines 10 - 11 and **Fig. 4**, "Fig. 4 provides a sample subscription page 400 that may be offered to the candidate user for establishing a content subscription."; Specification, p. 16, lines 12 - 14, discussing a "candidate subscription page for presentation to the user, an example of which is depicted in Fig. 4"; see also reference numbers **541**, **542** of **Fig. 5**, illustrating an "Interactive Subscription Page", and corresponding text on p. 17, lines 7 - 8);

- responsive to <u>acceptance</u> of the offered subscription by the user, <u>storing</u> the

markup language document <u>as a trigger</u> associated with the user and the content (Claim 1, lines 11 - 12; Specification, p. 16, lines 7 - 12 and **Fig. 6**, discussing an XML file where the column names from Web page content are used as XML tag values, this XML file being "created ... to correspond to the selective version of the candidate content" based on the portions of the Web page with which the user interacts; Specification, p. 17, lines 8 - 12, "... if the user decides to accept the suggested subscription ..." then passing information to a "trigger handler component"; see also **Fig. 15** and corresponding text at Specification, p. 23, lines 11 - 18, discussing an XML document [e.g., a document as shown in **Fig. 8**; Specification, p. 24, lines 10 - 12] that is passed **1504** to a "trigger handler component" **1540** which then transforms the XML document "into a trigger that a content matching engine **[1570]** understands", as well as Specification, p. 24, lines 10 - 17, where lines 15 - 16 thereof explain that the "set of formatted conditions" that are to be considered as a match when the content matching engine evaluates content "may alternatively be referred to as a 'trigger'");

- <u>subsequently evaluating the content generated</u> by the content source, <u>using the trigger,</u> to determine whether any of the at least one portion of the content is <u>considered a match</u> to the trigger (Claim 1, lines 13 - 15; Specification, p. 19, lines 13 - 17, referring to a "content matching engine" that performs "subsequent comparisons between patterns [from a subscription] and the content displayed in" a subscribed-to Web page; Specification, p. 20, lines 6 - 9, "Once the subscription information has been defined and processed, the source Web page will

subsequently be queried ... to determine whether any content matching the user's filter [i.e., content matching selected <u>conditions</u>; see Specification, p. 20, lines 9 - 10] is currently rendered in that Web page"; Specification, p. 24, lines 10 - 17, discussing the trigger handler [**1540 of Fig. 15**] "stor[ing] information about [what do to] when a particular match occurs"; Specification, p. 27, lines 7 - 14, discussing a content matching engine [**1570 of Fig. 15**] evaluating content "using triggers sent [**1505 of Fig. 15**] from the trigger handler component [**1540 of Fig. 15**]"); and

- <u>automatically sending each matching portion</u> of the content to the user as the subscription (Claim 1, lines 15 - 16; Specification, p. 21, lines 2 - 11, discussing events to be "invoked when the source Web age contains content matching the user's subscription filter", including "hav[ing] content delivered to a particular device [e.g. for the user to view]"; see also **710** and **712 of Fig. 7** and corresponding text at Specification, p. 21, lines 13 - 14 and p. 22, lines 10 - 13, respectively) *and* <u>scheduling time on an electronic calendar of the user</u> when any of the at least one portion of the content is considered a match to the trigger (Claim 1, lines 16 - 17; Specification, p. 22, line 14 - p. 23, line 1, discussing the "Schedule my calendar for ..." option shown at **720 - 722 of Fig. 7**).

2.   An example scenario is introduced on p. 9, line 17 - p. 11, line 21 of the Specification, which is illustrated in **Figs. 1** and **2**. Here, a user "John" views a Web page **100** from a Web site **110** in order to peruse information about computing devices and peripherals. An implementation

of the invention recognizes that John "is a repeat visitor" (Specification, p. 10, line 11) and

"therefore offer[s] him a subscription to the content of Web page 100" (Specification, p. 10, line

12). The subscription can specify conditions under which the user will receive an updated version

of the content (Specification, p. 11, lines 11 - 12) and also "one or more events that should be

invoked when specified conditions are met (where these events may or may not include content

delivery)" (Specification, p. 11, lines 12 - 14). The events are further discussed with reference to

Fig. 7, as noted above in para. 2, and include sending each matching portion of the content to the

user and scheduling time on the user's calendar. See, for example, reference numbers **710 - 712**

of **Fig. 7** and corresponding text on p. 21, line 9 - p. 22, line 13, discussing sending content to a

user's device, and reference numbers **720 - 722** of **Fig. 7** and corresponding text on p. 22, line 14

- p. 23, line 1, discussing <u>scheduling a time period</u> (such as 30 minutes) <u>on the user's calendar</u> to

give the user "time to review details of [the automatically-sent portion of content] that has been

detected using his/her subscription filter".

3.   Independent Claim 20 is a system claim reciting claim language analogous to Claim 1.

More particularly, independent Claim 20 is directed to a system for enabling users to subscribe to

content in a computing environment (Claim 20, line 1; Specification, p. 2, lines 1 - 3, "... enabling

end users to subscribe to information content ..."; p. 7, lines 17 - 19, "Use of the present invention

enables content providers ... to pro-actively offer content subscriptions to [users]"). Claim 20

further recites that this system comprises instructions which are executable to perform functions

comprising:

        •   identifying a <u>content access behavior pattern</u> of a user (Claim 20, line 5;

Specification, p. 7, lines 2 - 3, "The present invention provides techniques that enable a content provider to use programmatically-discovered/observed behavior patterns of users ..."; Specification, p. 9, lines 17 - 18, "The sample Web page 100 depicted in Fig. 1 is used herein to illustrate how an end user's behavior patterns may be observed and used to offer that user a content subscription ...");

- responsive to the identifying, consulting a mapping to determine a candidate content subscription to be offered to users exhibiting the identified behavior pattern, the candidate content subscription indicating at least one portion of content generated by a content source (Claim 20, lines 6 - 8; Specification, p. 7, lines 3 - 5, "... automatically query the users to determine whether they would like to subscribe to content which is ... relevant to the behavior patterns"; Specification, p. 12, lines 12 - 19, "... [an] inference engine may provide its observations [about identified user behavior patterns; Specification, p. 12, lines 2 - 3] to the CP2XML component ... [which then] consult[s] a mapping that associates selected behavior patterns with content subscriptions ... As yet another approach, a separate code component may be used [instead of the CP2XML component] for making this comparison ...");

- generating a markup language document representing the determined candidate content subscription (Claim 20, lines 9 - 10; Specification, p. 16, lines 6 - 14, explaining that an XML document is created and used to generate a "candidate subscription page for presentation to the user, an example of which is depicted in Fig. 4"; Specification, p. 24, lines 10 - 17, discussing an XML document that

specifies customization information (e.g., as shown in **Fig. 8**) which is then
formatted "into key-value pairs [for example] ... specifying conditions that are to
be considered as a match when the content matching engine evaluates content");

- offering, to the user, <u>a subscription</u> to the candidate content subscription using a
graphical user interface constructed using the markup language document (Claim
20, lines 11 - 12; Specification, p. 7, lines 3 - 5, "... automatically query the users
to determine whether they would like to subscribe to content which is ... relevant
to the behavior patterns"; Specification, p. 15, lines 10 - 11 and **Fig. 4**, "Fig. 4
provides a sample subscription page 400 that may be offered to the candidate user
for establishing a content subscription."; Specification, p. 16, lines 12 - 14,
discussing a "candidate subscription page for presentation to the user, an example
of which is depicted in Fig. 4"; see also reference numbers **541, 542** of **Fig. 5**,
illustrating an "Interactive Subscription Page", and corresponding text on p. 17,
lines 7 - 8);

- responsive to <u>acceptance</u> of the offered subscription by the user, <u>storing</u> the
markup language document <u>as a trigger</u> associated with the user and the content
(Claim 20, lines 13 - 14; Specification, p. 16, lines 7 - 12 and **Fig. 6**, discussing an
XML file where the column names from Web page content are used as XML tag
values, this XML file being "created ... to correspond to the selective version of
the candidate content" based on the portions of the Web page with which the user
interacts; Specification, p. 17, lines 8 - 12, "... if the user decides to accept the
suggested subscription ..." then passing information to a "trigger handler

component"; see also **Fig. 15** and corresponding text at Specification, p. 23, lines 11 - 18, discussing an XML document [e.g., a document as shown in **Fig. 8**; Specification, p. 24, lines 10 - 12] that is passed **1504** to a "trigger handler component" **1540** which then transforms the XML document "into a trigger that a content matching engine **[1570]** understands", as well as Specification, p. 24, lines 10 - 17, where lines 15 - 16 thereof explain that the "set of formatted conditions" that are to be considered as a match when the content matching engine evaluates content "may alternatively be referred to as a 'trigger'"");

- subsequently evaluating the content generated by the content source, using the trigger, to determine whether any of the at least one portion of the content is considered a match to the trigger (Claim 20, lines 15 - 17; Specification, p. 19, lines 13 - 17, referring to a "content matching engine" that performs "subsequent comparisons between patterns [from a subscription] and the content displayed in" a subscribed-to Web page; Specification, p. 20, lines 6 - 9, "Once the subscription information has been defined and processed, the source Web page will subsequently be queried ... to determine whether any content matching the user's filter [i.e., content matching selected conditions; see Specification, p. 20, lines 9 - 10] is currently rendered in that Web page"; Specification, p. 24, lines 10 - 17, discussing the trigger handler **[1540 of Fig. 15]** "stor[ing] information about [what do to] when a particular match occurs"; Specification, p. 27, lines 7 - 14, discussing a content matching engine **[1570 of Fig. 15]** evaluating content "using triggers sent **[1505 of Fig. 15]** from the trigger handler component **[1540 of Fig.**

15]"); and

- automatically sending each matching portion of the content to the user as the subscription (Claim 20, lines 17 - 18; Specification, p. 21, lines 2 - 11, discussing events to be "invoked when the source Web age contains content matching the user's subscription filter", including "hav[ing] content delivered to a particular device [e.g. for the user to view]"; see also **710** and **712** of **Fig. 7** and corresponding text at Specification, p. 21, lines 13 - 14 and p. 22, lines 10 - 13, respectively) *and* scheduling time on an electronic calendar of the user when any of the at least one portion of the content is considered a match to the trigger (Claim 20, lines 18 - 19; Specification, p. 22, line 14 - p. 23, line 1, discussing the "Schedule my calendar for ..." option shown at **720 - 722** of **Fig. 7**).

4. Independent Claim 21 is a computer program product claim reciting claim language analogous to Claim 1. More particularly, independent Claim 21 is directed to a computer program product for enabling users to subscribe to content in a computing environment (Claim 21, lines 1 - 2; Specification, p. 2, lines 1 - 3, "... enabling end users to subscribe to information content ..."; p. 7, lines 17 - 19, "Use of the present invention enables content providers ... to pro-actively offer content subscriptions to [users]"). Claim 21 further recites computer usable program code operable for:

- identifying a content access behavior pattern of a user (Claim 21, line 5; Specification, p. 7, lines 2 - 3, "The present invention provides techniques that enable a content provider to use programmatically-discovered/observed behavior

patterns of users ..."; Specification, p. 9, lines 17 - 18, "The sample Web page 100 depicted in Fig. 1 is used herein to illustrate how an end user's behavior patterns may be observed and used to offer that user a content subscription ...");

- responsive to the identifying, consulting a <u>mapping</u> to determine a <u>candidate</u> content subscription <u>to be offered to users</u> exhibiting the identified behavior pattern, the candidate content subscription indicating at least one portion of content generated by a content source (Claim 21, lines 6 - 8; Specification, p. 7, lines 3 - 5, "... automatically query the users to determine whether they would like to subscribe to content which is ... relevant to the behavior patterns"; Specification, p. 12, lines 12 - 19, "... [an] inference engine may provide its observations [about identified user behavior patterns; Specification, p. 12, lines 2 - 3] to the CP2XML component ... [which then] consult[s] a mapping that associates selected behavior patterns with content subscriptions ... As yet another approach, a separate code component may be used [instead of the CP2XML component] for making this comparison ...");

- generating a <u>markup language document</u> representing the determined candidate content subscription (Claim 21, lines 9 - 10; Specification, p. 16, lines 6 - 14, explaining that an XML document is created and used to generate a "candidate subscription page for presentation to the user, an example of which is depicted in Fig. 4"; Specification, p. 24, lines 10 - 17, discussing an XML document that specifies customization information (e.g., as shown in **Fig. 8**) which is then formatted "into key-value pairs [for example] ... specifying conditions that are to

be considered as a match when the content matching engine evaluates content");

- <u>offering</u>, to the user, <u>a subscription</u> to the candidate content subscription using a graphical user interface constructed using the markup language document (Claim 21, lines 11 - 12; Specification, p. 7, lines 3 - 5, "... automatically query the users to determine whether they would like to subscribe to content which is ... relevant to the behavior patterns"; Specification, p. 15, lines 10 - 11 and **Fig. 4**, "Fig. 4 provides a sample subscription page 400 that may be offered to the candidate user for establishing a content subscription."; Specification, p. 16, lines 12 - 14, discussing a "candidate subscription page for presentation to the user, an example of which is depicted in Fig. 4"; see also reference numbers **541, 542** of **Fig. 5**, illustrating an "Interactive Subscription Page", and corresponding text on p. 17, lines 7 - 8);

- responsive to <u>acceptance</u> of the offered subscription by the user, <u>storing</u> the markup language document <u>as a trigger</u> associated with the user and the content (Claim 21, lines 13 - 14; Specification, p. 16, lines 7 - 12 and **Fig. 6**, discussing an XML file where the column names from Web page content are used as XML tag values, this XML file being "created ... to correspond to the selective version of the candidate content" based on the portions of the Web page with which the user interacts; Specification, p. 17, lines 8 - 12, "... if the user decides to accept the suggested subscription ..." then passing information to a "trigger handler component"; see also **Fig. 15** and corresponding text at Specification, p. 23, lines 11 - 18, discussing an XML document [e.g., a document as shown in **Fig. 8**;

Specification, p. 24, lines 10 - 12] that is passed **1504** to a "trigger handler component" **1540** which then transforms the XML document "into a trigger that a content matching engine [**1570**] understands", as well as Specification, p. 24, lines 10 - 17, where lines 15 - 16 thereof explain that the "set of formatted conditions" that are to be considered as a match when the content matching engine evaluates content "may alternatively be referred to as a 'trigger'");

- <u>subsequently evaluating the content generated</u> by the content source, <u>using the trigger</u>, to determine whether any of the at least one portion of the content is <u>considered a match</u> to the trigger (Claim 21, lines 15 - 17; Specification, p. 19, lines 13 - 17, referring to a "content matching engine" that performs "subsequent comparisons between patterns [from a subscription] and the content displayed in" a subscribed-to Web page; Specification, p. 20, lines 6 - 9, "Once the subscription information has been defined and processed, the source Web page will subsequently be queried ... to determine whether any content matching the user's filter [i.e., content matching selected <u>conditions</u>; see Specification, p. 20, lines 9 - 10] is currently rendered in that Web page"; Specification, p. 24, lines 10 - 17, discussing the trigger handler [**1540** of **Fig. 15**] "stor[ing] information about [what do to] when a particular match occurs"; Specification, p. 27, lines 7 - 14, discussing a content matching engine [**1570** of **Fig. 15**] evaluating content "using triggers sent [**1505** of **Fig. 15**] from the trigger handler component [**1540** of **Fig. 15**]"); and

- <u>automatically sending each matching portion</u> of the content to the user as the

subscription (Claim 21, lines 17 - 18; Specification, p. 21, lines 2 - 11, discussing events to be "invoked when the source Web age contains content matching the user's subscription filter", including "hav[ing] content delivered to a particular device [e.g. for the user to view]"; see also **710** and **712** of **Fig. 7** and corresponding text at Specification, p. 21, lines 13 - 14 and p. 22, lines 10 - 13, respectively) *and* <u>scheduling time on an electronic calendar of the user</u> when any of the at least one portion of the content is considered a match to the trigger (Claim 21, lines 18 - 19; Specification, p. 22, line 14 - p. 23, line 1, discussing the "Schedule my calendar for ..." option shown at **720 - 722** of **Fig. 7**).

5.   The rejection of dependent Claims 3 - 4 and 13 - 19 is <u>not</u> separately argued herein, and a summary of their claimed subject matter is therefore not provided.

6.   None of the appealed claims includes means plus function terminology. Accordingly, a discussion of structure, material, or acts supporting such terminology is not provided herein.

6)   GROUND OF REJECTION TO BE REVIEWED ON APPEAL

7.   The **Ground of Rejection** presented for review is a rejection of Claims 1, 3 - 4, and 13 - 21 under 35 U. S. C. §103(a) as being unpatentable over U. S. Patent Publication 2004/0043758 to Sorvari et al. (hereinafter, "Sorvari") in view of U. S. Patent 6,731,393 to Currans et al. (hereinafter, "Currans").

7) ARGUMENT

8.   Paragraph 4 of the Office Action dated July 31, 2009 (hereinafter, "the Office Action") states that Claims 1, 3 - 4, and 13 - 21 are rejected under 35 U. S. C. §103(a) as being unpatentable over Sorvari in view of Currans.

9.   With regard to an obviousness rejection under 35 U. S. C. §103, MPEP §2143.03 (which is titled "All Claim Limitations Must Be Considered" and which is found within Section MPEP §2143, titled "Examples of Basic Requirements of a *Prima Facie* Case of Obviousness") quotes *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970), which held that "All words in a claim must be considered in judging the patentability of that claim against the prior art." (emphasis added)

10.   Appellants will now demonstrate that the Office Action has not made out a *prima facie* case of obviousness under 35 U.S.C. §103 for their claims, because the cited references – whether taken singly or in combination – do not teach, or suggest, what Appellants have claimed, when considering all words of the claims according to MPEP §2143.03.

7.1)   Independent Claims 1, 20, and 21

11.   Independent Claims 1, 20, and 21 stand or fall together. The Office Action analysis of these independent claims will now be discussed, demonstrating that the references do not render the claims unpatentable.

12.   Referring first to Claim 1, this claim has been discussed above in paragraphs 1 - 2. The

Office Action analysis is presented in paras. 5 - 12 of the Office Action.

13.   At the outset, Appellants respectfully note that the Office Action analysis <u>fails to state</u>

what <u>part</u> of a cited text passage or figure is being relied on, or <u>how any part of that text passage</u>

<u>or figure is being interpreted</u> by the Examiner, when discussing their claim language. This

provides Appellants with little to no guidance for formulating a response to the rejection.

Accordingly, Appellants have been left to guess as to what the Examiner is actually citing, <u>and</u>

<u>how that has been interpreted</u>.

14.   Furthermore, Appellants refer to the requirements set out in 37 CFR §1.104, "Nature of

Examination", which states in paragraph (c)(2),

> In rejecting claims for ... obviousness, the examiner must cite the best
> references at his or her command. When a reference is complex or shows or
> describes inventions other than that claimed by the applicant, <u>the particular part</u>
> <u>relied on must be designated as nearly as practicable</u>. The <u>pertinence</u> of each
> reference, if not apparent, <u>must be clearly explained</u> ... (emphasis added)

Appellants respectfully submit that it is <u>practicable</u> to designate which portions of a paragraph are

being relied on, rather than simply reciting a group of paragraph numbers with <u>no discussion</u> of

any of the material from those paragraphs. Appellants also respectfully submit that the <u>pertinence</u>

of material contained within a group of numbered paragraphs is <u>not apparent</u> merely by listing

those paragraph numbers. Appellants respectfully submit that the approach to analyzing their

claim language in the Office Action is therefore <u>legally deficient</u>, as it does not meet these

requirements from 37 CFR §1.104.

15.   Turning now to the claim language, lines 4 - 6 of Claim 1 recite "responsive to the identifying, consulting a mapping to determine a candidate content subscription to be offered to users exhibiting the identified behavior pattern, the candidate content subscription indicating at least one portion of content generated by a content source" (emphasis added). The Office Action analysis in para. 7 merely states "(e.g., ¶ 0061 - 0067; 0073 - 0078)", which are paragraph numbers from Sorvari. The Office Action fails to indicate what it is from these 13 cited paragraphs that is being asserted as teaching Appellants' "mapping", and what is asserted as teaching "candidate content subscription", and what is asserted as teaching "at least one portion of content generated by a content source". Does the Office Action analysis presume, for example, that Sorvari's "database of past services accessed by the user" (para. **[0061]**, lines 3 - 4) is analogous to Appellants' recited "candidate content subscription" (Claim 1, lines 4 and 5)? If so, how are past services accessed by the user (or, more generally, services) supposedly the same thing as content? And if services are being equated to content in the Office Action analysis, then what is being equated to Appellants' recited "at least one portion of content" (Claim 1, line 6, emphasis added)? Is there somehow a "portion" of a service – and if so, where is that disclosed in Sorvari? Appellants respectfully submit that the Office Action analysis has failed to establish that Sorvari discloses these recited terms from lines 4 - 6 of Appellants' Claim 1.

16.   Lines 7 - 8 of Claim 1 recite "generating a markup language document representing the determined candidate content subscription". The Office Action analysis in para. 8 merely states "(e.g., ¶ 0166 - 0173 & Figures 10 - 11H)", referring again to Sorvari. The Office Action fails to indicate what it is from these 8 cited paragraphs and the 9 cited figures (noting that these figures,

when taken together, appear to contain <u>hundreds</u> of words) that is being asserted as teaching Appellants' "generating a markup language document". Appellants note that para. **[0166]** does discuss a markup language document – in particular, an XML document. However, Appellants find <u>no teaching</u> in Sorvari that such an XML document "represent[s] the determined candidate <u>content</u> subscription", as recited on lines 7 - 8 of Appellants' Claim 1 (emphasis added).

17.   Appellants also respectfully note that their "markup language document" as recited on lines 7 - 8 of Claim 1 is further referenced on lines 11 - 12 of Claim 1, which recite "storing the markup language document <u>as a trigger</u> associated with the user and the content" (emphasis added), where this storing occurs "<u>responsive to acceptance</u> of the offered subscription by the user" (Claim 1, line 11, emphasis added). Paragraph 10 of the Office Action presents the analysis of lines 11 - 12 of Claim 1, and merely states "(e.g., ¶ 0166 - 0173 & Figures 10 - 11H)", repeating the same reference to Sorvari as provided in paras. 8 and 9 of the Office Action. However, the Office Action <u>fails to indicate what it is</u> from these 8 cited paragraphs and the 9 cited figures that is being asserted as teaching Appellants' "storing the markup language document <u>as a trigger</u>" (Claim 1, lines 11 - 12, emphasis added) and Appellants are unable to find any disclosure in the cited paragraphs and figures that can be equated to this claim language. Furthermore, Appellants are unable to find any disclosure in the cited paragraphs and figures of <u>storing</u> that occurs "responsive to acceptance of [an] offered subscription by the user" (Claim 1, line 11).

18.   In view of paras. 15 - 17 above, it can be seen that the Office Action analysis has failed

to consider <u>all the words</u> of Claim 1, in violation of the above-quoted MPEP §2143.

19.   Appellants take note of the <u>admission</u> in para. 11 of the Office Action that Sorvari "does not specifically teach the subsequently evaluating further comprises scheduling time on an electronic calendar of the user ...". Paragraph 12 of the Office Action then cites Currans as teaching this claim language – that is, as teaching the recited "and <u>scheduling time</u> on an electronic calendar of the user <u>when any of the at least one portion of the content is <i>considered a match</i> to the <i>trigger</i>"</u> from lines 16 - 17 of Claim 1 (emphasis added). However, the Office Action analysis of Currans merely states "e.g., col. 12, line 58 - col. 13, line 52 & Figures 6 - 8)" without providing any information as to the purported relevance of the cited figures and text to Appellants' claim language. Appellants respectfully submit that <u>under no interpretation</u> do the cited figures and text teach, or suggest, the claim language for which they are cited, as will now be demonstrated in paras. 20 - 24, below.

20.   The cited **Fig. 6** of Currans illustrates a graphical user interface where a user can "tell us about yourself". See the title in the figure. In col 3, lines 29 - 30, Currans describes **Fig. 6** as "show[ing] how <u>user profile information is acquired</u> from a user ..." (emphasis added). Appellants are <u>unable to determine any relevance</u> of this figure to their claim language that pertains to scheduling time on a user's calendar, as the figure contains <u>no entries pertaining to time</u> and <u>no entries pertaining to a calendar</u>.

21.   Currans describes his **Fig. 7** as "show[ing] a <u>print schedule for the delivery of documents</u>

...". Col. 3, lines 31 - 32, emphasis added. For example, **Fig. 7** indicates that document **11000**

was printed on May 27, 1999 at 2:40 pm while document **12000** was printed on May 27, 1999 at

7:10 pm. At col. 10, lines 1 - 3, Currans states "**FIG. 7** shows one example of <u>printing schedule</u>

390, of the type that might be used in an enhanced version of HP's Instant Delivery program."

(emphasis added), and col. 12, lines 39 - 41 state "Referring again to <u>print schedule</u> **390** shown in

FIG. 7, it can be seen that many different types of documents can be required to be printed."

(emphasis added). Appellants respectfully submit that these citations clearly show that Currans'

Fig. 7 – and the printing schedule illustrated therein – is <u>not</u> pertinent to <u>scheduling time on a</u>

<u>user's calendar</u>. Furthermore, the Office Action <u>fails to disclose</u> how **Fig. 7** supposedly teaches

scheduling time on a user's calendar "when any of the ... content is considered a match to the

trigger" as recited on lines 16 - 17 of Appellant's Claim 1.

22.   At col. 3, lines 33 - 34, Currans describes his **Fig. 8** as "show[ing] how the <u>print schedule</u>

of **FIG. 7** can be modified by the user" (emphasis added). This is also stated at col. 13, lines 26 -

27. Appellants are unable to determine how allowing a user to modify a <u>document printing</u>

<u>schedule</u> is <u>in any way</u> relevant to scheduling time on a user's calendar – and in particular,

scheduling time on the calendar "when any of the ... content is considered a match to the trigger"

as recited on lines 16 - 17 of Appellant's Claim 1.

23.   Referring now to the cited text from col. 12, line 58 - col. 13, line 52 of Currans, this text

addresses a document **12000** that may be a daily calendar which has been requested by the user to

print automatically at a certain time of day (see col. 12, lines 58 - and lines 61 - 65; a print

schedule of a document **13000** which is a user's "personalized newspaper" (see col. 13, lines 11 -

12 and lines 17 - 20); a print schedule **390** which can be edited by the user to control when

documents are printed (see col. 13, lines 27 - 28 and lines 30 - 33); a document **11000** printed by

a printing device (see col. 13, lines 40 - 41); and a document **12000** printed by a printing device

(see col. 13, lines 48 - 49). Requesting that a document is <u>automatically printed</u> at a certain time

of day (such as document **11000** illustrated in **Figs. 9A - 9B** or document **13000** illustrated in

Figs. 11A - 11D), as discussed in the cited text, <u>fails to disclose</u> scheduling time on the calendar,

and also fails to disclose <u>anything</u> about "when ... content is considered a match to [a] trigger".

While document **12000** as illustrated in **Fig. 10** "is a user's daily calendar" (col. 13, line 50),

Appellants respectfully submit that <u>nowhere in the cited text</u> does Currans disclose <u>scheduling</u>

<u>time on</u> a user's calendar "when any of the ... content is considered a match to the trigger" as

recited on lines 16 - 17 of Appellant's Claim 1.

24.   Furthermore, for the claim language "any of the at least one portion of the content" which

is recited on lines 16 - 17 of Claim 1, Appellants note that the <u>antecedent</u> for this claim language

is found on lines 5 - 6 of Claim 1, where it is recited as follows:

> <u>the candidate content subscription indicating</u> at least one portion of content
> generated by a content source (emphasis added)

It is necessary to consider this antecedent in order to evaluate <u>all of the words</u> of the claim

language as required by the above-cited MPEP §2143.03. In other words, the time is scheduled

on the user's calendar (Claim 1, line 16) when some portion of content matches a trigger (Claim

1, lines 16 - 17), this portion of content having been <u>indicated in a candidate content subscription</u>

(Claim 1, lines 5 - 6). Appellants find <u>no disclosure</u> of this claim language in the cited figures and/or text of Currans when considering <u>all the words</u> recited in Claim 1. That is, what in Currans is supposedly equivalent to Appellants' recited "at least one portion of content", and where is the "candidate content subscription" in which such portion is indicated?

25.   Appellants also respectfully submit that the purported motivation for combining Sorvari and Currans is flawed, as will now be discussed with reference to paras. 26 - 30, below.

26.   The motivation for combining Sorvari and Currans is presented on page 4, lines 3 - 8 of the Office Action, stating

> ... because utilizing a user calendar to have information sent to the user
> enables the user to dictate when they would receive information and not have
> information sent every time a match is made from the trigger. This would also
> lessen the amount of network traffic in the system.

27.   Appellants note that this is the <u>exact same motivation</u> that was asserted for combining U. S. Patent 6,094,681 of <u>Shaffer</u> with Sorvari when analyzing dependent Claim 6 (from which the "scheduling time ..." claim language currently recited on lines 16 - 17 of Claim 1 was taken; see Claim 6 in Appellants' submission dated March 29, 2008) in para. 26 of the Office Action dated March 6, 2009. Notably, the disclosure of <u>Currans</u> pertains to a "System and Related Methods for Automatically Determining Media Type in a Printing Device Media Tray" (see the Title of Currans) whereas <u>Shaffer</u>'s previously-cited disclosure pertains to "Apparatus and Method for Automated Event Notification" (see the Title of Shaffer). It appears unlikely that the teachings of such <u>unrelated</u> topics as Shaffer and Currans are interchangeable. <u>Reusing</u> the motivation for

combining references, *verbatim*, while changing the secondary reference from Shaffer to Currans appears to suggest that combining the disclosure of Currans with the disclosure of Sorvari has not been thoroughly evaluated before presentment of the asserted motivation in the Office Action.

28.   Appellants also note that the Court of Appeals for the Federal Circuit has stated, in ***In re Dembiczak***, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999), that to support combining references, evidence of a suggestion, teaching, or motivation to combine <u>must be clear and particular</u>, and this requirement for clear and particular evidence <u>is not met by broad and conclusory statements about the teachings</u> of references. Appellants respectfully submit that the <u>reused motivation</u> in the Office Action is evidence that <u>broad and conclusory statements</u> are used in the Office Action as a purported motivation for combining the references, in violation of this holding from ***In re Dembiczak***.

29.   Furthermore, Appellants respectfully note that their claim language in Claim 1 does <u>not</u> recite <u>sending information</u> to the user <u>at a scheduled time</u>, or sending information as "dictated" by a user, in sharp contrast to the asserted motivation for combining Sorvari and Currans. Rather, Appellants' claim language recites "automatically sending each matching portion of the content to the user as the subscription and [also] scheduling time on an electronic calendar ... when ... at least one portion of the content" matches the trigger (Claim 1, lines 15 - 17). In other words, the claim language does <u>not</u> recite that the user "dictates" when the information is sent to the user, and in sharp contrast to the assertion in the Office Action, the claim language recites that the information is <u>automatically sent</u> to the user when it matches the trigger.

30.   Appellants also respectfully submit that the Office Action has <u>failed to demonstrate</u> that a combination of Sorvari and Currans would yield what Appellants have claimed (assuming, *arguendo*, that such combination could be made and that one of skill in the art was motivated to attempt it). Appellants note that the extent of the Office Action explanation of Sorvari's "use" of a calendar is as follows: "Sorvari teaches the use of calendar information", citing para. **[0308]**. Office Action, page 3, last 4 lines. However, what is described in the cited para. **[0308]** is "... an <u>input</u> ... <u>from</u> a calendar application program indicating that a meeting is starting in 25 minutes time" (para. **[0308]**, lines 1 - 5, emphasis added) or as another example of an input, "... the calendar application program indicates that Lisa is having a birthday tomorrow ..." (para. **[0308]**, lines 5 - 8). Receiving <u>input</u> from a calendar application program, as in these cited portions of para. **[0308]**, indicates that events are <u>already scheduled</u> on the user's calendar, which <u>in no way</u> teaches or suggests Appellants' recited "scheduling time on an electronic calendar of the user when any of the at least one portion of the content is considered a match to the trigger" as recited on lines 16 - 17 of Claim 1. In fact, <u>it is entirely unclear</u> what would result from combining Sorvari's <u>receiving input about an already-scheduled event</u> with Currans' <u>scheduling the printing of a document at a particular time</u>, and Appellants find <u>no interpretation</u> under which a combination of these disclosures yields their recited "scheduling time on an electronic calendar ... when any of the at least one portion of the content is considered a match to the trigger" as recited on lines 16 - 17 of Claim 1 (emphasis added).

31.   In view of the above, it can be seen that the Office Action <u>fails to demonstrate</u> that the references teach Appellants' claim language as recited in Claim 1 when considering <u>all of the</u>

words recited therein as required by the above-quoted MPEP §2143.03. A *prima facie* case of obviousness has therefore <u>not been made out</u> as to Claim 1, and without more, Claim 1 is deemed patentable over the references. See ***In re Oetiker***, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992), which stated:

> If the examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent.

32.   Independent Claims 20 and 21 recite claim language analogous to that of Claim 1, and the Office Action does not provide a separate evaluation of these independent claims. See Office Action, para. 5. Accordingly, Appellants respectfully submit that the arguments presented above apply equally to Claims 20 and 21, demonstrating that these claims are also <u>not rendered obvious</u> by the references.

7.2)   Dependent Claims 3 - 4 and 13 - 19

33.   Dependent Claims 3 - 4 and 13 - 19 stand or fall with independent Claim 1 from which they depend. These dependent claims are therefore deemed patentable over the references by virtue of the patentability of Claim 1, the patentability of which is discussed above in "**7.1) Independent Claims 1, 20, and 21**".

8)   CONCLUSION

For the reasons set out above, Appellants respectfully contend that each appealed claim is patentable, and respectfully request that the Examiner's rejection of the appealed claims should be

reversed.

Respectfully submitted,

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CLAIMS AS CURRENTLY PRESENTED:

1   Claim 1: A computer-implemented method of enabling users to subscribe to content in a

2   computing environment, comprising:

3   identifying a content access behavior pattern of a user;

4   responsive to the identifying, consulting a mapping to determine a candidate content

5   subscription to be offered to users exhibiting the identified behavior pattern, the candidate content

6   subscription indicating at least one portion of content generated by a content source;

7   generating a markup language document representing the determined candidate content

8   subscription;

9   offering, to the user, a subscription to the candidate content subscription using a graphical

10   user interface constructed using the markup language document;

11   responsive to acceptance of the offered subscription by the user, storing the markup

12   language document as a trigger associated with the user and the content; and

13   subsequently evaluating the content generated by the content source, using the trigger, to

14   determine whether any of the at least one portion of the content is considered a match to the

15   trigger and automatically sending each matching portion of the content to the user as the

16   subscription and scheduling time on an electronic calendar of the user when any of the at least one

17   portion of the content is considered a match to the trigger.

Claim 2 (canceled)

1   Claim 3: The computer-implemented method according to Claim 1, further comprising:

2   enabling the user to customize the offered subscription from the graphical user interface

3   prior to acceptance of the offered subscription, such that at least one condition is placed on at

4   least one of the at least one portion of the content; and

5   revising the markup language document to include each of the at least one condition prior

6   to the storing.

1   Claim 4: The computer-implemented method according to Claim 3, wherein the subsequently

2   evaluating further comprises determining whether each of the at least one condition is considered

3   a match to the trigger and only sending the matching portion of the content and scheduling the

4   time on the electronic calendar if so.

     Claims 5 - 12 (canceled)

1   Claim 13: The computer-implemented method according to Claim 1, wherein the subsequently

2   evaluated content comprises a then-current version of the content generated by the content

3   source.

1   Claim 14: The computer-implemented method according to Claim 1, wherein the subsequently

2   evaluating is invoked responsive to a timer.

1   Claim 15: The computer-implemented method according to Claim 1, wherein the subsequently

2   evaluating is invoked responsive to occurrence of an event.

1   Claim 16: The computer-implemented method according to Claim 1, wherein the identifying is

2   performed by an inference engine.

1   Claim 17: The computer-implemented method according to Claim 1, wherein the identifying

2   comprises determining whether the user exhibits any of a plurality of predetermined content

3   access behavior patterns.

1   Claim 18: The computer-implemented method according to Claim 1, wherein the content is

2   rendered on a Web page and the identifying comprises identifying how the user interacts with the

3   Web page.

1   Claim 19: The computer-implemented method according to Claim 18, wherein the Web page

2   lacks a subscription interface for enabling the user to subscribe to the rendered content.

1   Claim 20: A system for enabling users to subscribe to content in a computing environment,

2   comprising:

3   a computer comprising a processor; and

4   instructions which are executable, using the processor, to performs functions comprising:

5   identifying a content access behavior pattern of a user;

6   responsive to the identifying, consulting a mapping to determine a candidate

7   content subscription to be offered to users exhibiting the identified behavior pattern, the candidate

8   content subscription indicating at least one portion of content generated by a content source;

9   generating a markup language document representing the determined candidate

10   content subscription;

11   offering, to the user, a subscription to the candidate content subscription using a

12   graphical user interface constructed using the markup language document;

13   responsive to acceptance of the offered subscription by the user, storing the

14   markup language document as a trigger associated with the user and the content; and

15   subsequently evaluating the content generated by the content source, using the

16   trigger, to determine whether any of the at least one portion of the content is considered a match

17   to the trigger and automatically sending each matching portion of the content to the user as the

18   subscription and scheduling time on an electronic calendar of the user when any of the at least one

19   portion of the content is considered a match to the trigger.

1   Claim 21: A computer program product for enabling users to subscribe to content in a computing

2   environment, the computer program product comprising at least one computer usable storage

3   medium having computer usable program code embodied therein, the computer usable program

4   code operable for:

5   identifying a content access behavior pattern of a user;

6   responsive to the identifying, consulting a mapping to determine a candidate content

7   subscription to be offered to users exhibiting the identified behavior pattern, the candidate content

8   subscription indicating at least one portion of content generated by a content source;

9   generating a markup language document representing the determined candidate content

10   subscription;

11   offering, to the user, a subscription to the candidate content subscription using a graphical

12   user interface constructed using the markup language document;

13   responsive to acceptance of the offered subscription by the user, storing the markup

14   language document as a trigger associated with the user and the content; and

15   subsequently evaluating the content generated by the content source, using the trigger, to

16   determine whether any of the at least one portion of the content is considered a match to the

17   trigger and automatically sending each matching portion of the content to the user as the

18   subscription and scheduling time on an electronic calendar of the user when any of the at least one

19   portion of the content is considered a match to the trigger.

EVIDENCE APPENDIX

Appellants, the Appellants' legal representative, and the assignee have no personal knowledge of evidence requiring separate identification herein as bearing on this Appeal.

RELATED PROCEEDINGS APPENDIX

Commonly-assigned and co-pending related application 10/733,985, titled "Customized Subscription Builder", is currently under appeal. The Appeal number for this related application is 2009-013555.